



Docket No.: 1293.1948

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Young-sig KWON

Serial No. 10/674,477

Group Art Unit: 2187

Confirmation No. 4673

Filed: October 1, 2003

Examiner: Than Vinh NGUYEN

For: RECORDING METHOD AND RECORDING APPARATUS USING SAME

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the Final Office Action mailed February 9, 2009 finally rejecting claims 1, 2, 5-9, 12-16 and 18-22 of the above-identified application.

The present request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached pages.

Respectfully submitted,

STAAS & HALSEY LLP

Dated: May 11, 2009

By: 

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Status of claims

Claims 1, 2, 5-9, 12-16 and 18-20, 23 and 24 are pending and under consideration. Claims 1, 8 and 18-20 are independent claims. Claims 18-20 are allowed.

Claims 1, 2, 5-9, 12-16, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0156338 A1 by Kudo et al. ("Kudo").

Applicant asserts the rejections are improper for at least the reasons provided below.

Reasons for Request for Review

Reason Number 1

The final rejection under 35 U.S.C. § 103(a) is improper because Kudo fails to suggest or disclose all of the features of independent claims 1 and 8.

By way of example and not limitation claim 1 recites at least the following:

building table of contents information using the record data to be recorded in a lead-in region of the optical recording medium among the record data stored in the buffer...

sequentially recording the data in a raw recording mode on the lead-in region, a program region, and a lead-out region of the optical recording medium.

The Final Office Action asserts at page 3, item 11, that Kudo describes all of the above-recited features at paragraphs [0011], [0012], [0185], [0186], [0196] - [0198] and [0204]- [0214]. Applicant respectfully disagrees with the Office Action assertion and requests reconsideration for at least the following reasons.

Kudo is directed to a system adapted to record or "dub" audio data read from a compact disc to a Mini-disc (MD) or a hard disc, or to dub audio data recorded in a hard disc to a MD, or to dub audio from an MD to a hard disc. Although Kudo appears to describe building TOC information based on a target medium in order to dub the audio data to each medium, Kudo does not describe "sequentially recording the data in a raw recording mode on the lead-in region, a program region, and a lead-out region" **after** building the TOC information on the data in the buffer as claimed.

In fact, the Office Action fails to establish that Kudo is different than a conventional raw recording mode, described by way of example and not limitation at paragraphs [0004] – [0006] of the present application. In such a conventional raw recording mode, data transmitted from a host is sequentially recorded on a read-in region, a program region, and a read-out region of an optical recording medium. **After** completion of the recording of the data on the lead-out region,

the lead-in region on which the data has already been recorded at a low rotation speed is sought using an optical pickup, and *then* the TOC information of the optical recording medium is built, at which time the recording process is complete.

Accordingly, Applicant respectfully asserts that independent claim 1 patentably distinguish over Kudo, and should be allowable for at least the above-mentioned reasons. Since similar features are recited by independent claim 8, with potentially differing scope and breadth, the rejection of claim 8 should be also be withdrawn.

Further, claims 2, 5-7, 9, and 12-16 variously depend from independent claims 1 and 8, and should be allowable for at least the same reasons as claims 1 and 8, as well as for the additional features recited therein.

Reason Number 2

The Final Office Action fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a) in the rejection of claims 1, 2, 5-9, 12-16 and 18-20, 23 and 24 because the Final Office Action does not sufficiently demonstrate that the proposed modification of Kudo would have been obvious.

At page 4 of the Final Office Action states:

Thus, it would be obvious, by Office Notice, to one of ordinary skills in the art to implement the Sub Q data being 16 bytes, or any specific size, to fulfill the data size requirement of a specific application.

With respect to the taking of Official Notice in a Final rejection, MPEP §2144.03.A states:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

Applicant specifically points out the following errors in the Office Action:

First, the Office Action uses common knowledge as the principal reason for the rejection, but fails to demonstrate that the Officially Noticed fact is "capable of instant and unquestionable demonstration as being well-known" as required by M.P.E.P. § 2144.03A.

Second, there is no evidence supporting the assertion. See M.P.E.P. § 2144.03C ("If Applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the Examiner must support the finding with adequate evidence").

Third, it appears that the rejection is based, at least in part, on personal knowledge. 37 C.F.R. § 1.104(d)(2) requires such an assertion to be supported with an affidavit when called for by the Applicant. Thus, Applicant calls for support for the assertion with an affidavit.

For each of these reasons, Applicant asserts the Final Office Action fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a).